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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,998	10/16/2003	Patrick J. Sweeney	029815-0103	7428

26371 7590 10/11/2006

FOLEY & LARDNER LLP  
777 EAST WISCONSIN AVENUE  
MILWAUKEE, WI 53202-5306

EXAMINER
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BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/686,998

Applicant(s)

SWEENEY, PATRICK J.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5-15, 17, 18, 21-25, 27-30, 32-34, 36-41, 43, 61-66 and 68-70 is/are pending in the application.
- 4a) Of the above claim(s) 10, 12, 18, 22, 28, 37, 43, 66 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-9, 11, 13-15, 17, 21, 23-25, 27, 29, 30, 32-34, 36-41, 62-65, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-06</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to amended claims 1, 3, 5-6, 32-34 and 36-41 have been considered but are moot in view of the new ground(s) of rejection. The remaining claims remain rejected as in the prior office action.

The screws and screw retainers of Rabbe et al and Strnad et al are capable of securing a pedicle to the prosthesis. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable** of performing the intended use, then it meets the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13-15, 17, 21, 23-25, 27, and 29-30 remain rejected under 35 U.S.C. 102(b) as being anticipated by Rabbe et al. (5,702,453) as cited in Applicant's IDS. Rabbe et al. discloses a spinal implant system, comprising: a vertebral prosthesis having a support and an endplate, wherein the support is adjustable to change the height of the vertebral prosthesis (Fig. 3); pedicle screw retainer (e.g. 46) and a pedicle screw (e.g. 5).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-9, 11, 13-15, 17, 21, 23-25, 27, 29-30, 32-34, 36, 38-41, and 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabbe et al.

(5,702,453) in view of Downey (5,147,404) as cited in Applicant's IDS. Rabbe et al. discloses a spinal implant system as above. However, Rabbe et al. does not disclose the implant coupled to an artificial disc. Downey teaches the use of an artificial disc coupled to a vertebral prosthesis (e.g. col. 3, lines 55-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of an artificial disc of Downey, to the vertebral prosthesis of Rabbe, so that "relatively little, if any flexibility is lost" as found in Downey (col. 2, lines 48-57).

Claims 61-65 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strnad et al. (6,296,665) in view of Downey (5,147,404) as cited in Applicant's IDS. Strnad et al. discloses a spinal implant system (Figs. 8a-9), comprising: a vertebral prosthesis having a support and an endplate, wherein the support is adjustable by sliding and uses a locking ring (110), a pedicle screw and retainer (202). However, Strnad et al. does not disclose the implant coupled to an artificial disc. Downey teaches the use of an artificial disc coupled to a vertebral prosthesis (e.g. col. 3, lines 55-65). It would have been obvious to one having ordinary skill in the art at the

time the invention was made to combine the teaching of an artificial disc of Downey, to the vertebral prosthesis of Strnad et al., so that "relatively little, if any flexibility is lost" as found in Downey (col. 2, lines 48-57).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached on Mon. -Fri. from 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas C. Barrett  
Examiner  
Art Unit 3738

A handwritten signature in black ink that reads "Tom Barrett". The signature is stylized with a large, sweeping initial "T" and a cursive "Barrett".

TOM BARRETT  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700